DOCKET NO: 287417US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
VOLKER HENNIGE, ET AL.	: EXAMINER: FORTUNA, ANA M.
SERIAL NO: 10/575,268	:
FILED: APRIL 11, 2006	: GROUP ART UNIT: 1797
FOR: CERAMIC, FLEXIBLE MEMBRANE PROVIDING IMPROVED ADHESION TO THE SUPPORT FLEECE	:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Advisory Action of July 23, 2009 and the Final Office Action of June 4, 2009, Applicants request pre-appeal review of the rejections in the present application in view of the following remarks submitted concurrently with a Notice of Appeal.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

The claims stand rejected as obvious under the meaning 35 U.S.C. § 103 in view of Hennige (CA 2,477,062) (see paragraph no. 2 on page 2 and paragraph no. 3 on pages 2-4 of the of the June 4, 2009 and December 22, 2008 Office Actions, respectively). The claims further stand rejected for obviousness-type double patenting (see paragraph no. 2 on page 2 and paragraph no. 5 on pages 5-7 of the June 4, 2009 and December 22, 2008 Office Actions, respectively).

Applicants submit that the rejections are not supportable in view of clear factual and/or legal errors and thus the rejections should be withdrawn.

The presently claimed invention is drawn to a membrane having a ceramic coating. The ceramic coating includes a first fraction and a second fraction. The second fraction is described as follows in Claim 1:

> wherein the second fraction comprises a silicon network bonded (i) via oxygen atoms to said oxides of said ceramic coating, (ii) via organic radicals to said polymeric nonwoven and (iii) **via at least one carbon chain to a further silicon atom**, . . .

See the claims on pages 2-8 of the Amendment of March 9, 2009.

Applicants submit that the Office's assertion that this feature of the presently claimed invention is disclosed in the Hennige patent is a clear factual error meriting withdrawal of the rejection.

Applicants disclose that the combination of two adhesion promoters containing alkyl groups that can react with one another to form a covalent bond is a basis from which the silicon network of the second fraction of the ceramic coating of Claim 1 may be formed (see page 3, lines 11-18 of the specification and the paragraph bridging pages 2 and 3 through page 4 of the July 7, 2009 Amendment). The Office appears to take the position that Hennige

inherently discloses the silicon network structure recited in the present claims because Hennige suggests the use of a combination of two adhesion promoters in a ceramic coating (see page 2, third full paragraph of the July 23, 2009 Advisory Action). The Office erroneously asserts the following:

> ". . . Applicant's allege[d] "improve adhesion" is inherent over the suggested mixtures in the [Hennige patent]."

See lines 2-3 of page 3 of the July 23, 2009 Advisory Action.

The Office's assertion that Hennige discloses a silicon network such as that described in present Claim 1 is not correct. Nowhere in Hennige is there disclosure of a ceramic coating that comprises a silicon network that is bonded "via at least one carbon chain to a further silicon atom".

Applicants submit the Office's assertion to the contrary is a factual error meriting withdrawal of the rejection.

Further, the Office errs legally by asserting that the Hennige compositions inherently have the silicon network recited in the present claims. The Office's assertion is incorrect as a matter of law because (i) Hennige, at best, only suggests mixtures of adhesion promoters, and (ii) there is no evidence of record establishing that such mixtures inherently provide the silicon network structure recited in the present claims.

The Office's assertion is legally incorrect as set forth in *In re Robertson*.

> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so-recognized by the persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Applicants submit that the Office's assertion of inherency is incorrect as a matter of law and thus the rejection should be withdrawn.

The obviousness-type double patenting rejections in view of co-pending applications 10/524,153 and 10/524,669, in combination with Hennige, likewise suffer from the defects noted above. The Office failed to demonstrate that the silicon network recited in the present claims is an inherent feature of the claims of the co-pending applications. Further, to the extent the Office relies on Hennige in support of the obviousness-type double patenting rejection, the rejection is legally not supportable because, as explained above, the Office's reliance on Hennige is both legally and factually incorrect.

Applicants thus submit that withdrawal of the obviousness-type double patenting rejections is now appropriate.

For the reasons discussed above in detail, Applicants request withdrawal of the rejections and the allowance of all now-pending claims.

Respectfully submitted,

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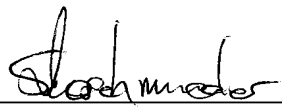
MAIER & NEUSTADT, L.L.P.
Norman F. Oblon



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